

REMARKS

The above amendment with the following remarks is submitted to be fully responsive to the Office Action of May 2, 2006. Reconsideration of this application in light of the amendment and the allowance of this application are respectfully requested.

Claims 1-11 and 23-52 were pending in the present application prior to the above amendment. In response to the Office Action, independent claims 1 and 33 have been amended, and claims 3, 32, 35 and 52 have been cancelled. Therefore, claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 are still pending in the present application and are believed to be in proper condition for allowance. No new matter is introduced. Reconsideration in view of the above amendments and following remarks is respectfully requested.

The present Office Action rejects claims 33-52 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, rejects claims 35 and 52 under 35 U.S.C. § 112, as being indefinite, rejects claims 1-11 and 23-52 under 35 U.S.C. § 102 as being anticipated by U.S. Patent Application No. 20020032612 to *Williams et al.*, and rejects claims 3, 27, 35, and 48 under 35 U.S.C. § 103, as being obvious in view of *Williams et al.* and U.S. Patent Application No. 20020065738 to *Riggs et al.*

In response to the rejection of claims 33-52 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, claims 1 and 33 have been amended to include a rendering data for display step and means respectively. (See Specification ¶¶ 42 and 43). No new matter is introduced. Accordingly, claims 33-52 are in compliance with 35 U.S.C. § 101 and no further rejection on such a basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to contact the undersigned attorney, who will be happy to work with the Examiner in a joint effort to derive mutually satisfactory claim language.

In response to the rejection of claims 35 and 52 under 35 U.S.C. § 112 as being indefinite, claims 35 and 52 have been cancelled. Accordingly, these claims are no longer pending in the present application and rejection of the claims is rendered moot.

In response to the rejection of claims 1-11 and 23-52 under 35 U.S.C. § 102 as being anticipated by U.S. Patent Application No. 20020032612 to *Williams et al.*, claims 1 and 33 have been amended to include a step and means respectively for determining whether the package requires customs clearance and, if so, electronically generating (or means for electronically generating) the appropriate customs documentation or data transmission to a

customs broker. Further, claims 3 and 35 have been cancelled. The pending claims are patently distinguishable over *Williams et al.* because *Williams et al.* fails to disclose all of the features of the pending claims. For example, independent claim 1, as amended (emphasis added), recites:

A computer-implemented method for **processing shipment and return of a package containing items** from a Sender to a Recipient, the method comprising the steps of:

electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs;

electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism;

electronically adding the shipment tracking data to the database;

electronically correlating the package data in the database with the shipment tracking data for the package;

electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker;

permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package; and

rendering data for display to an authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one more items of the items of the package.

independent claim 33, as amended (emphasis added), recites:

A computer-implemented system for **processing shipment and return of a package containing items** from a Sender to a Recipient, the system comprising:

means for electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs;

means for electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender;

means for electronically adding the shipment tracking data to the database;

means for electronically correlating the package data in the database with the shipment tracking data for the package;

means for electronically determining whether the package requires customs clearance and, if so, electronically generating the

appropriate customs documentation or data transmission to a customs broker;

means for **permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package; and**

means for **rendering data for display to an authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one more items of the items of the package.**

Thus, the pending independent claims 1 and 33 are directed to a novel method and system for processing shipment and return of a package to destinations worldwide. (See Specification ¶ 29). Advantageously, the Applicant's invention supports international shipping and tracking of packages and package contents. (See Specification ¶¶ 17 and 19). Further, the invention automates the process of preparing packages for customs clearance and generating the necessary supporting documentation and data. *Williams et al.* fails to disclose the international shipping and customs features of the inventions recited in independent claims 1 and 33; thus, *Williams et al.* does not anticipate the present invention.

Additionally, as the examiner points out, *Williams et al.* "does not explicitly teach the steps of electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker and generating appropriate customs forms." (Office Action, May 2, 2006). Accordingly, the inventions recited in claims 1 and 33 are patentably distinguishable over *Williams et al.*, and believed to be in proper condition for allowance.

Referencing Examiner's argument that *Williams et al.* "discloses that product information is repeated for every product in the package. . . . [thus] the products in the package are distinguished from the package itself thereby enabling tracking of each product," such that *Williams et al.* discloses the features in the present application of "correlating package data, for the package, and including item data, for the items in the package, with shipment tracking data for the package," the Applicant respectfully disagrees. (See Office Action, May 2, 2006, page 7). *Williams et al.* appears to disclose a return tracking system where item data is stored **upon the return** of the item by the Recipient. Advantageously, the Applicant's invention is distinct from *Williams et al.* because **individual items within a**

package are tracked before being shipped by the Sender. (See Specification ¶ 17). To further define the scope of the invention and expedite the prosecution of the present application, claim 1 has been amended to recite that the storing of package data, including item data, occurs **before** package shipment.

Williams et al., fails to disclose all of the features of the Applicant's invention as recited in independent claims 1 and 33. Further, claims 2, 4-11, 23-31, 33, 34, and 36-51 are dependent from the above independent claims. For this reason and at least the reasons stated above, the claims are believe to be in a condition for allowance and withdraw of the 35 U.S.C. § 102 rejection with respect to *Williams et al.* is respectfully requested.

In response to the rejection of claims 3, 27, 35, and 48 under 35 U.S.C. § 103, as being unpatentable over *Williams et al.* in view of U.S. Patent Application No. 2002/0065738 to *Riggs et al.*, Applicant wishes to bring to the Examiner's attention the Declaration filed under 37 C.F.R. § 1.132 on November 30, 2001. The Declaration indicates the commercial success of the present invention. The Declaration was timely filed and is evidence relevant to the present invention as indicia of unobviousness. As such, the Applicant requests the Examiner to consider the Declaration. (See MPEP 716.01(a)). For this reason, the claims are believed to be in a condition for allowance and withdraw of the 35 U.S.C. § 103 rejection of claims 3, 27, 35 and 48 with respect to *Williams et al.* in view of *Riggs et al.* is respectfully requested.

To further expedite prosecution of the application, claims 3 and 35 have been canceled. In view of the amendment, dependent claims 27 and 48 are allowable over *Williams et al.*, and *Riggs et al.*, alone or in combination, on their own merits and for at least the reasons as argued above with respect to independent claims 1 and 33 and dependent claims 3 and 25. Thus, rejection of claims 27 and 48 under 35 U.S.C. § 103 is respectfully requested.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Respectfully submitted,

NIXON PEABODY, LLP

/Carlos R. Villamar, Reg. # 43,224/

Carlos R. Villamar

Reg. No. 43,224

NIXON PEABODY LLP

CUSTOMER NO.: 22204

401 9th Street, N.W., Suite 900

Washington, DC 20004

Tel: 202-585-8000

Fax: 202-585-8080